

Appl. No. 09/994,199
Amd. Dated January 29, 2004
Reply to Office Action Dated 10/29/2003

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Claims 1-38 remain in this application.

Claim Amendments

While not required by the Examiner, Applicant has made claim amendments to capture additional subject matter and resolve certain clarity issues. For example, for consistency, Applicant has amended the claims to recite optical reaction rather than change. These and/or other broadening and/or clarity changes are reflected in claims 1-4, 6, 8-13, 15, 19-31 and 33-34.

Rejection(s) under 35 U.S.C § 102(b)

Claims 1-4, 7, 10, 11, 15, 16, 18, 20-23, 35, 36 and 38 are rejected under 35 U.S.C. § 102(b) as being anticipated by Abercrombie (US 4,605,065). Applicant respectfully traverses the rejection.

Applicant's claims 1-19 relate to methods for identifying the presence of hydrogen sulfide in a wellbore or performing reservoir analysis using a downhole tool comprising or having a sample of material. Applicant's claims 20-38 relate to a downhole tool comprising or having a sample of material. The sample of material is optically reactive to the presence of hydrogen sulfide. If hydrogen sulfide is present, an optical reaction can be detected by removing the downhole tool from the wellbore and inspecting the coupon, or by using sensors to detect the optical reaction.

Abercrombie fails to teach, disclose or even suggest such a method or downhole tool and sample of material. Abercrombie relates to a corrosion monitor for use in a well tubing mandrel. *See Abercrombie, Abstract*. The well tubing mandrel includes concentric metal conduits

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extending from the bottom of the well to the surface for pumping fluids through the wellbore. *See Abercrombie, Col. 1, lines 14-20.* A carrier is used to place the corrosion monitor into a notch in the tubing. *See Abercrombie, Col. 2, lines 21-30.* The corrosion monitor detects corrosives as they pass through the tubing. After a certain time, the carrier removes the coupon from the tubing for inspection. *See Abercrombie, Col. 2, lines 30-32 and 38-40.* This apparatus for monitoring well tubing fluid is significantly different from the downhole tool and sample of material combination of Applicant's claims. In fact, Abercrombie teaches away from the downhole tool and coupon combination as recited in Applicant's claims by providing that a separate carrier is used to dispose a coupon into the tubing of the wellbore.

In view of the above, Applicant submits that the over the art of record fails to anticipate Applicant's claims. Applicant, therefore, requests withdrawal of the rejection under 35 U.S.C. § 102.

Rejection(s) under 35 U.S.C § 103

Claims 5, 6, 8, 9, 12, 13, 14, 17, 19, 24-31, 32-34, and 37 are rejected under 35 U.S.C. § 103 as being obvious over Abercrombie (US 4,605,065) in combination with Waterman, GB 2344365, Williams, and/or Monel. Applicant respectfully traverses the rejection. The Examiner has failed to establish a prima facie case of obviousness based on the cited references.

As discussed above, Abercrombie, the primary reference, teaches away from the downhole tool and coupon combination as recited in Applicant's claims by providing that a coupon is disposed into a wellbore tubing using a carrier. The references of record fail to provide the deficiencies of Abercrombie. Like Abercrombie, Williams relates to the placement of a corrosion coupon inside production tubing, and fails to even suggest the downhole tool and

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sample of material combination. Waterman refers to a stand-alone monitoring probe, not a downhole tool. Monel does not even discuss any type of downhole operation.

Moreover, there is no motivation to combine the cited references as suggested by the Examiner. Waterman teaches away from positioning a coupon within the flow of fluid for an interval of time as provided by Abercrombie. *See Waterman, col. 1, lines 31-48 and Abercrombie, col. 2, lines 30-38.* Thus, one of skill in the art would be deterred from combining the teachings of Waterman with the teachings of Abercrombie. There is also no motivation to combine Abercrombie with GB2344365. Abercrombie is a well production device and GB2344365 is a sampling tool. Absent improper hindsight reconstruction, one of skill in the art would not be motivated to combine such techniques. Thus, there is no basis for combining Abercrombie with Waterman or GB2344365.

For at least these reasons, Applicant respectfully submits the art of record fails to anticipate or render obvious any of Applicants' Claims. Moreover, Applicant respectfully submits that none of the art of record teaches, discloses or even suggests Applicant's claimed invention. Applicant, therefore, requests withdrawal of the rejection Applicant's Claims under 35 U.S.C. §§ 102 and/or 103 based on the cited art and allow Applicant's claims.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned at the telephone number listed below.

This paper is submitted in response to the Office Action dated October 29, 2003 for which the three-month date for response is January 29, 2004. Please apply any charges not covered, or any credits, to Deposit Account 19-0610 (Reference Number 20.2756).

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Respectfully submitted,

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